APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,130	11/12/1999	AKIRA SAKAGUCHI	JA9-98-217	1265

25259   7590   01/15/2003

IBM CORPORATION
3039 CORNWALLIS RD.
DEPT. T81 / B503, PO BOX 12195
REASEARCH TRIANGLE PARK, NC   27709

EXAMINER
BURGESS, BARBARA N

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 November 2002</u> .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-11</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-11</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This is in response to applicant's amendment filed on November 6, 2002. Claims 1-11 are

presented for further examination.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 2-3, 5, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt

et al. (hereinafter "Hunt", 5,764,235) in view of Katsurabayashi et al. (hereinafter "Kat",

5,996,002).

As per claims 2 and 3, Hunt discloses:

- Generating an image file in response to specifying image data by an operator of said client

   terminal (column 2, lines 34-40, column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5,

   column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-23, 49-

   51);

- Converting said image file to generate a predetermined formed compressed image data which

   has a file name relating to said unique image file name (column 1, lines 48-51, column 8,

   lines 50-52, column 9, lines 6-15);

- Displaying said predetermined formed compressed image data of said server on a Web browser on said client terminal (column 3, lines 10-12, 49-52, column 5, lines 43-55, column 10, lines 44-49, column 11, lines 11-13, column 12, lines 20-23).

Whenever a server stores, retrieves, or sends a file to a client terminal as a result of a request, the server gives a unique file name to the file in order to distinguish the requested file from other files that are stored on, retrieved, or sent from the server and allowing a record of the transmission to be stored in the server's log or database (column 2, lines 34-43, 47-48, 50-52, column 4, line 66, column 5, lines 1-6, 23-29, column 8, lines 41-44, column 11, lines 5-9). Therefore, determining a unique image file name from the server is implicit in Hunt's disclosure.

Hunt does not explicitly disclose:

- Sending said predetermined formed compressed image data to said server.

However, the use and advantages for sending the image data to the server is well known to one skilled in the relevant art at the time the invention was made as evidenced by the teachings of Kat. Kat discloses data created by an operator of a client computer sending the data to an "individual data sender" (server) for sending the individual data to other computers (abstract, column 4, lines 4-19).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate sending image data to the server in Hunt's method in order for the changed data to be passed from the operator of the client computer to other computers in response to a command from the specific operator who created the individual or changed data.

As per claim 5, Hunt discloses a method of communicating on a communication system having a client terminal connecting a server through a network, said client terminal comprising means for determining the amount of image data that is needed according to the display size (column 3, lines 47-54, column 11, lines 7-9, 40-42, column 12, lines 46-50). Therefore, Hunt implicitly discloses a screen range selector for specifying a screen range in response to operation for specifying screen range by an operator.

Hunt further discloses generating an image file in response to specifying an image area by an operator of said client terminal (column 2, lines 34-40, column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5, column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-23, 49-51). Therefore, Hunt implicitly discloses an image file generator for acquiring an image according to said screen range and generating an image file.

Whenever a server stores, retrieves, or sends a file to a client terminal as a result of a request, the server gives a unique file name to the file in order to distinguish the requested file from other files that are stored on, retrieved, or sent from the server allowing a record of the transmission to be stored in the server's log or database (column 2, lines 34-43, 47-48, 50-52, column 4, line 66, column 5, lines 1-6, 23-29, column 8, lines 41-44, column 11, lines 5-9). Therefore, a file name acquisition division for acquiring an original name from said server is implicitly taught in Hunt's disclosure.

Hunt further discloses means to convert an image file to generate a predetermined formed compressed image data (column 1, lines 48-51, column 8, lines 50-52, column 9, lines 6-15). Therefore, Turpin implicitly discloses an image file converter.

Hunt also discloses displaying the image data on the Web browser of the client terminal (column 5, lines 49-54, column 10, lines 47-49). Therefore, Hunt implicitly discloses a display division for displaying said predetermined formed compressed image data of said server on a Web browser on said client terminal.

Hunt does not explicitly disclose:

• A file transmitter for sending to said server said predetermined formed compressed image data.

However, the use and advantages for sending the image data to the server is well known to one skilled in the relevant art at the time the invention was made as evidenced by the teachings of Kat. Kat discloses data created by an operator of a client computer sending the data to an "individual data sender" (server) for sending the individual data to other computers (abstract, column 4, lines 4-19).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate sending image data to the server in Hunt's method in order for the changed data to be passed from the operator of the client computer to other computers in response to a command from the specific operator who created the individual or changed data.

As per claims 9 and 10, Hunt discloses a computer readable media containing program instructions for directing said client terminal to generate an image file in response to specifying image data by an operator of said client terminal, directing said client terminal to unique image

file name from the server, directing said client terminal to convert said image file to generate a

predetermined formed compressed image data which has a file name relating to said unique

image file name, and directing said client terminal to display said predetermined formed

compressed image data of said server on a Web browser on said client terminal (column 3, lines

30-41, column 15, lines 33-67, column 16, lines 1-3, 13-15, 20-24). Therefore, Hunt implicitly

discloses a storage medium storing a software product for controlling communication performed

on a communication system said software product comprising the program codes for directing

said client terminal to generate an image file in response to specifying image data by an operator

of said client terminal, directing said client terminal to unique image file name from the server,

directing said client terminal to convert said image file to generate a predetermined formed

compressed image data which has a file name relating to said unique image file name, and

directing said client terminal to display said predetermined formed compressed image data of

said server on a Web browser on said client terminal.

Hunt does not explicitly disclose:

- Directing said client terminal to send to said server said predetermined formed compressed
  image data to said server.

However, the use and advantages for sending the image data to the server is well known to one

skilled in the relevant art at the time the invention was made as evidenced by the teachings of

Kat. Kat discloses data created by an operator of a client computer sending the data to an

"individual data sender" (server) for sending the individual data to other computers (abstract,

column 4, lines 4-19).

Therefore, one of ordinary skill in the art at the time the invention was made would have

found it obvious to implement or incorporate sending image data to the server in Hunt's method

in order for the changed data to be passed from the operator of the client computer to other

computers in response to a command from the specific operator who created the individual or

changed data.

3.   Claims 1 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt et

al. (hereinafter "Hunt", 5,764,235) in view of Peterson et al. (hereinafter "Peterson", 6,502,137

B1).

As per claim 1, Hunt, discloses a method of communication on a communication system

having a client terminal connecting to a server through a network and implicitly collaborating

with other client terminals connected to said network, said method comprising the steps of:

- Generating an image file in response to specifying an image area by an operator of said client

  terminal (column 2, lines 34-40, column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5,

  column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-23, 49-

  51);

- Converting said image file to generate a predetermined formed compressed data which has a

  file name relating to said image file name (column 1, lines 48-51, column 8, lines 50-52,

  column 9, lines 6-15);

- Displaying said predetermined formed compressed data of said server on a Web browser on
  said client terminal (column 3, lines 10-12, 49-52, column 5, lines 43-55, column 10, lines
  44-49, column 11, lines 11-13, column 12, lines 20-23).

Hunt further discloses receiving a file name from the server. Whenever a server stores,

retrieves, or sends a file to a client terminal as a result of a request, the server gives a unique file

name to the file in order to distinguish the requested file from other files that are stored on,

retrieved, or sent from the server allowing a record of the transmission to be stored in the

server's log or database (column 2, lines 34-43, 47-48, 50-52, column 4, line 66, column 5, lines

1-6, 23-29, column 8, lines 41-44, column 11, lines 5-9). Therefore, Hunt teaches acquiring an

image file name from the server.

Hunt also discloses an image processing that image files undergo at the server to customize

the images before being sent to the client. This process modifies the image file using

compression (column 5, lines 18-33, column 8, lines 31-52). Therefore, Hunt implicitly

discloses sending said predetermined formed compressed image data to said server.

Hunt fails to explicitly disclose:

- Posting the file name of said predetermined formed compressed image data to the client
  terminals collaborating with said client terminal.

However, the use and advantages for implementing this step is well known to one skilled in the

relevant art at the time the invention was made as evidenced by the teachings of Peterson

(column 3, lines 55-61).

Therefore, one of ordinary skill in the art at the time the invention was made would have

found it obvious to implement or incorporate posting the file name of said predetermined formed

compressed image data to the client terminals collaborating with said client terminal in Hunt's method in order for the receiving clients to know what the data is although it may have been translated.

As per claim 7, Hunt fails to explicitly disclose posting the file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal.

However, the use and advantages for implementing this step is well known to one skilled in the relevant art at the time the invention was made as evidenced by the teachings of Peterson (column 3, lines 55-61).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate posting the file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal in Hunt's method in order for the receiving clients to know what the data is although it may have been translated.

As per claim 8, Hunt fails to explicitly disclose a storage medium storing a software product, said software product comprising the computer program code for:

• Directing said client terminal to post file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal.

However, the use and advantages for implementing this step is well known to one skilled in the

relevant art at the time the invention was made as evidenced by the teachings of Peterson

(column 3, lines 55-61).

Therefore, one of ordinary skill in the art at the time the invention was made would have

found it obvious to implement or incorporate posting the file name of said predetermined formed

compressed image data to the client terminals collaborating with said client terminal in Hunt's

method in order for the receiving clients to know what the data is although it may have been

translated.

4.   Claims 4, 6, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt et al.

(hereinafter "Hunt", 5,764,235) in view of Blumer et al. (hereinafter "Blumer", 5,732,219).

As per claim 4, Hunt discloses a method of communicating on a communication system

comprising:

- A client terminal connecting with a network and a server connecting with said network

   (column 4, lines 63-66, column 5, lines 34-39);

- Storing a file created by an operator of said client terminal which has a name capable of

   determining that it was created by said operator (column 4, line 66, column 5, lines 1-2, 23-

   29, column 8, lines 41-44, column 11, lines 5-9);

- Receiving a message sent from the client terminal including information capable of

   identifying said operator (column 2, lines 34-40, column 3, lines 2-4, 18-19, column 5, lines

   26-28, column 11, lines 7-9);

- Acquiring the information capable of identifying said operator included in said message (column 2, lines 37-39, column 3, lines 15-16, column 5, lines 23-29, column 11, lines 7-9);

Whenever a server stores, retrieves, or sends a file to a client terminal as a result of a request, the server gives a unique file name to the file in order to distinguish the requested file from other files that are stored on, retrieved, or sent from the server and allowing a record of the transmission to be stored in the server's log or database (column 2, lines 34-43, 47-48, 50-52, column 4, line 66, column 5, lines 1-6, 23-29, column 8, lines 41-44, column 11, lines 5-9). Therefore, the use of acquiring a file name of the file created by operator on said information capable of identifying said operator is implicit in Hunt's disclosure.

Hunt further discloses, sending the image file to the client terminal to be displayed with the web page (column 10, lines 37-49). Whenever a file is sent to a client terminal, the file name, which is acquired from the server, is sent with the file. Therefore, posting the file name of said image data to the client terminal is inherent in Hunt's disclosure.

Hunt does not explicitly disclose:

- Generating a file list file by inserting said file name into a skeleton file.

However, the use and advantages of generating a file list file is well known to one skilled in the relevant art at the time the invention was made as evidenced by the teachings of Blumer (column 3, lines 17-24, column 4, lines 36-40).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate generating a file list in Hunt's method in order to access documents stored on the server.

As per claim 6, Hunt discloses receiving a message sent from the client terminal including

information capable of identifying said operator (column 2, lines 34-40, column 3, lines 2-4, 18-

19, column 5, lines 26-28, column 11, lines 7-9). Therefore, Hunt implicitly discloses a message

analysis division for receiving a message sent from said client terminal including information

capable of identifying said operator and acquiring said information.

Hunt does not explicitly disclose:

• Generating a file list file by inserting said file name into a skeleton file.

However, the use and advantages of generating a file list file is well known to one skilled in the

relevant art at the time the invention was made as evidenced by the teachings of Blumer (column

3, lines 17-24, column 4, lines 36-40).

Therefore, one of ordinary skill in the art at the time the invention was made would have

found it obvious to implement or incorporate generating a file list in Hunt's method in order to

access documents stored on the server.

As per claim 11, Hunt discloses a computer readable media containing program instructions

for receiving a message sent from the client terminal including information capable of

identifying said operator, acquiring the information capable of identifying said operator included

in said message, generating a file list file by inserting said file name into a skeleton file,

acquiring a file name of the file created by operator on said information capable of identifying

said operator, posting the file name of said image data to the client terminal (column 3, lines 30-

41, column 15, lines 33-67, column 16, lines 1-3, 13-15, 20-24). Therefore, Hunt implicitly

discloses a storage medium storing a software product for controlling communication performed

on a communication system having a client terminal connecting with a network and a server

connecting with said network and storing a file created by an operator of said client terminal

which has a file name capable of determining that it was created by said operator, said software

product comprising the program codes for directing said server to receive a message sent from

the client terminal including information capable of identifying said operator, directing said

server to acquire the information capable of identifying said operator included in said message,

directing said server to acquire a file name of the file created by operator on said information

capable of identifying said operator, directing said server to post the file name of said image data

to the client terminal.

Hunt does not explicitly disclose:

- Generating a file list file by inserting said file name into a skeleton file.

However, the use and advantages of generating a file list file is well known to one skilled in the

relevant art at the time the invention was made as evidenced by the teachings of Blumer (column

3, lines 17-24, column 4, lines 36-40).

Therefore, one of ordinary skill in the art at the time the invention was made would have

found it obvious to implement or incorporate generating a file list in Hunt's method in order to

access documents stored on the server.

Response to Arguments

1.   Applicant's arguments with respect to claims 1-23 have been considered but are moot in

view of the new ground(s) of rejection.

In response to Applicant's request for reconsideration filed on November 6, 2002, the following

factual arguments are noted:

a.   Claims 2, 3, 5, 9, and 10 recite sending image data to server. This feature is not taught by

Hunt.

b.   Claims 4, 6, and 11 all recite generating a file list file by inserting a file name into a

skeleton file. This feature is not taught by Hunt.

c.   In addition claimed feature of posting the file name of the image data to a client terminal,

which is incorporated in claims 1 and 7-8, is also not taught or suggested by the references.

d.   The two prior art references are directed toward entirely different problems from both

each other and the problem the Applicant's invention solves.

In considering (a)-(d), Applicant's arguments have been considered but are moot in view of the

new ground(s) of rejection.

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

U.S. Patent No. 5,699,528

U.S. Patent No. 5,809,242

U.S. Patent No. 6,073,241

U.S. Patent No. 5,892,908
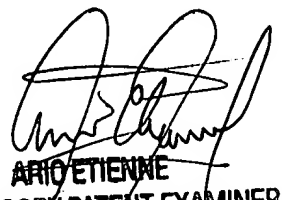
U.S. Patent No. 5,911,776

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N Burgess whose telephone number is (703) 305-3366. The examiner can normally be reached on M-F (8:00am-4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

<div style="text-align:right">
Barbara N Burgess
Examiner
Art Unit 2153
</div>

***

January 13, 2003

ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100